



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,024	03/16/2001	Holger Eggers	Mo-6053/WW-5060	5684

7590

04/01/2003

NORRIS MCLAUGHLIN & MARCUS, P.A.
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER

RIBAR, TRAVIS B

ART UNIT

PAPER NUMBER

1711

12

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/811,024

Applicant(s)

EGGERS ET AL.

Examiner

Travis B Ribar

Art Unit

1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,4-11 and 13-15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: The applicant argues the combination of Khanna and Mizutani and the applicability of the teachings therein to the present application. The applicant raises the issue that the product in the references is not the same as the present invention because the process used to create the present invention does impart patentable properties to the product and points to various places in the specification that support this position. The applicant also specifically argues the necessary presence of a cooling roll in the process used to make the present invention.

The examiner agrees that certain properties of the present invention are the result of the process used to make the invention, as the examples in the present application show. However, the examples do not show that the processes used in Khanna would not inherently provide the same product. Like the applicant, Khanna discloses a method for making a nucleated polymer that includes an extrusion method (column 8, line 47 and column 10, lines 55-62) followed by a cooling period (column 11, lines 5-14). Also like the applicant, Khanna shows that it is advantageous to cool the extrudate quickly, to a temperature below 50 degrees Celsius (column 2, line 44) in order to form only small crystals in the polymer.

The only apparent differences in the method of making the polymer of the present invention and the polymer in Khanna are the exact temperature of cooling and the fact that the polymer in Khanna is cooled within a mold. The temperature aspect of the cooling step in Khanna is not explicitly disclosed, but it would be obvious to one skilled in the art to maintain the mold at room temperature, which is essentially the temperature that the applicant uses in their examples (20 degrees Celsius is about room temperature). Regarding the presence of the mold, the applicant has not shown that this aspect of the method impacts their invention in any manner.

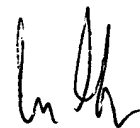
The applicant's assertion that the cooling roll is integral to the invention does not appear to be supported by the applicant's specification. The specification discloses that methods of cooling the extrudate other than by using a cooling roll may be used to obtain the present invention (page 11, lines 16-20). The applicant is also reminded that only claim 11 presently includes process steps to which a product-by-process argument would be drawn.

Since the method in the reference appears to be sufficiently close to the method the applicant claims and since the materials present in the combination of references is the same as the materials in the present application, the examiner maintains his position regarding the product-by-process limitations in the present application.

The applicant also argues that properties the examiner deemed inherent to the combination of references are not so. However, the materials used in the references cited are the same as the materials used in the present application and the methods used in the references cited appear to be equivalent to the applicant's methods. Therefore, the properties the applicant claims would appear to be inherently present in the invention taught through the combination of references that the examiner cited.

The applicant's argument regarding the lack of anisotropic filler particles in the spherulites falls under the inherency argument. A given material processed using a given method will produce a product having given properties. As the references teach the same material processed using an equivalent method, the product produced by the references will have the same properties as the applicant's product. This includes the spherulite structure and amounts thereof. Here the examiner notes the applicant's argument that the addition of a nucleating agent would cause spherulites to form that incorporate the nucleating agent. This argument is not enough to overcome the references because not only would the examiner's inherency argument still apply, but the applicant has also not claimed a structure in which no spherulites incorporate the nucleating agent.

The examiner therefore maintains his positions put forth in the office action dated December 9, 2002.



James J. Seidieck
Supervisory Patent Examiner
Technology Center 1700